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28857 7590 09/07/2005
CRAIG W. RODDY
HALLIBURTON ENERGY SERVICES
P.O. BOX 1431
DUNCAN, OK 73536-0440

EXAMINER

RICHARD, CHARLES R

ART UNIT PAPER NUMBER

1712

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,443

Applicant(s)

LUKE ET AL.

Examiner

C. R. Richard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-105 is/are pending in the application.
- 4a) Of the above claim(s) 1-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 33-105 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-105 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/18/03 to 7/5/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35

U.S.C. 121:

- I. Claims 1-32, drawn to a method for displacing a fluid, classified in class 166, subclass 312.
- II. Claims 33-105, drawn to a treating fluid (and methods of treating a well bore with this fluid), classified in class 507, subclass 269.

The inventions are distinct, each from the other because of the following reasons. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, both can be shown. There are of course fluids other than those claimed that can be used in displacement (such as water displacing some other, non-zeolite containing fluid), and other processes can make use of the product besides displacement (such as drilling).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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During a telephone conversation with Applicant's attorney, Priscilla Ferguson, on August 1, 2005, a provisional election was made without traverse to prosecute the invention of group II (claims 33-105). Affirmation of this election must be made by Applicant in replying to this Office action. Claims 1-32 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

2. This application contains claims directed to groups of patentably distinct species of the claimed invention.

Species Group I : zeolites (see species in claims 39&40 and 77&78).

Species Group II: polymers (see species in claims 52 and 90).

Species Group III: dispersants (see species in claims 58 and 96).

Species Group IV: surfactants (see species in claims 61&62 and 99&100).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for each of the four groups given above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Applicant's attorney, Priscilla Ferguson, on August 1, 2005, a provisional election was made without traverse to prosecute (I) the zeolite clinoptilolite; (II) the polymer hydroxyethyl cellulose; (III) the dispersant sodium naphthalene sulfonate condensed with formaldehyde; and (IV) the surfactant species (f) of claims 62 and 100 (a specified ethoxylated alcohol ether sulfate). Affirmation of this election must be made by Applicant in replying to this Office action. The other species of these groups are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

3. The Examiner has NOT considered French language document 763,998 listed on the form 1449 received 12 May 2004. There is a failure to comply with 37 CFR 1.98(a)(3) as there is no concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. This reference has been placed in the application file, but the information referred to therein has not been considered.

4. Applicant has submitted search reports and exam report on various related/counterpart applications. It is difficult to comment on the relevance of the "X" references cited therein, because of restrictions, species elections and possible differences in claims numbers. Suffice it to say that the Examiner has considered these reports and references and if such a reference is not cited against Applicant in this Office Action, it did not apply or the Examiner has found more appropriate art to apply.

Allowable Subject Matter

5. With respect to the elected species, there is some allowable subject matter over the cited prior art. The specific combinations of the zeolite clinoptilolite (I) and the polymer hydroxyethyl cellulose (II); (I) and the dispersant sodium naphthalene sulfonate condensed with formaldehyde; and (I) and the surfactant species (f) of claims 62 and 100 (a specified ethoxylated alcohol ether

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sulfate) represent this allowable subject matter – at least in the context of the claims as presently presented. There are no allowable claims, since no claims are limited only to one or more of these specific combinations, and the claims as written are all rejectable over the cited prior art.

Note that the rejections made below are based on the claims as they read and not only to the elected species. This will allow for more speedy overall prosecution and make it easier for Applicant to make appropriate amendments. Other, as yet non-elected, species are sometimes pointed out below.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 37, 47-48, 50-51, 75, 85-86, 88-89 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, there is overlap between components in these claims. A zeolite may be considered a viscosifier, a colloidal agent and/or a clay.

8. Claims 39 and 77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The parameter “x” is not

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completely defined. There are no numerical limits given, and it does not seem likely that just any number would work in the situation.

9. Claims 62 and 100 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The superscript 4+ is impossible in the structure as shown. There is also no counter ion shown.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 33-40, 43-44 and 47-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Kiss et al. in US Patent 4,772,307. Kiss describes a process

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wherein contaminated water is brought into contact with the zeolite, clinoptilolite and/or mordenite (see Abstract). The zeolite is at least suspended in a [carrier] fluid that may include a sewage sludge – which would inherently contain organic polymers/viscosifiers/colloids (see column 9, lines 25-31 and claim 5 step (e) of Kiss). The composition disclosed here by Kiss could be used in any of a variety of well treatments as a drilling, spacing or similar fluid. Note the admission in the specification that states that “all zeolites” may be represented by the same formula - matching exactly that of claim 39 (see page 3, paragraph 13 of the specification and claim 39).

12. Claims 33-41, 43-45, 47-48, 50, 68-79, 81-83, 85-86 and 88 are rejected under 35 U.S.C. 102(b) as being anticipated by Cross et al. in US Patent 2,094,316. Cross discloses a well/drilling fluid containing zeolites (see claims 1 and 3 of Cross). Various types of zeolites are discussed including zeolite clays, base exchange (Na/Ca-Mg) zeolites and even natrolite (note that claims such as 40 and 78 are comprising) (see column 2, lines 1-11 and column 3, lines 30-35); note (as will be shown important below) that natrolite is similar to clinoptilolite (see specification at page 3, paragraph 14). The zeolites may be added at 1 to 10 percent in water alone or the zeolite may be added to an oil well mud already made to increase viscosity or improve its sealing properties (see column 3, line 50 to column 4, line 10). The fluids of Cross are of course inherently capable of being used as spacers. Iron oxides may be present (see column 3, line 37) which are weighting agents as the zeolite may be considered itself. The step of

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introducing the fluid into the well bore, drilling, and producing oil is implied in the statement of the uses for the fluids given above.

As to claims 39 and 77, recall the admission made on page 3 of the specification mentioned above and note the zeolite analyses in column 3 of Cross.

13. Claims 33-39, 43-44, 47-48, 52-56, 68-77, 81-82, 85-86 and 90-94 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller et al. in US Patent 4,888,120. Mueller discloses well drilling and servicing fluids.

Muller teaches aqueous based well servicing fluids (including drilling, cleaning and carriers) containing layered silicate which *may* be mixed with a thickening polymer (that may be hydroxyethyl cellulose) (see column 3, lines 25-50). Zeolites such as zeolite Na A may be added (see column 4, lines 35-45). The steps of the rejected method claims are implied in the uses taught for the fluids. Note that about zero percent includes zero percent in claims 56 and 94.

14. Claims 33-35, 37-39, 41-50, 52-56, 65, 68-73, 75-77, 79-88, 90-94 and 103 are rejected under 35 U.S.C. 102(b) as being anticipated by Terry et al. in US Patent 5,711,383. Terry discloses drilling fluids and drilling methods comprising water, viscosifier and cementitious material (see Abstract).

The viscosifier may be a polymer such as hydroxyethyl cellulose and/or a clay such as bentonite (see column 3, lines 14-31); the viscosifier is present generally at 0.1 to 50 pounds per barrel of fluid (see column 3, lines 28-31). The

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cementitious material may be a zeolite (see column 4, lines 17-23), especially at 5 to 250 pounds per barrel of fluid (see column 5, lines 15-20). The fluid may be used in drilling a well bore and also in cementing the casing (see column 5, lines 25-40). Weighting materials like barite may be used (see Examples). Other steps of the rejected claims not mentioned are implied in the teachings of uses.

15. Claims 33-35, 37-39, 43-44, 61-64, 68-73, 75-77, 81-82 and 99-102 are rejected under 35 U.S.C. 102 (a) and (e) as being anticipated by Roddy in US Patent 6,457,524. Roddy teaches well cementing (completion) compositions and methods.

The compositions of Roddy may contain (among other components) a cement material (a viscosifier), a flow enhancing zeolite, water and the ethoxylated alcohol ether sulfate surfactant shown on line 35 of column 5 of the reference (corresponding exactly to surfactant (f) of claims 62 and 100) (see columns 4 and 5 of Roddy). The surfactant may be present in an amount given via an involved discussion in columns 5 and 6 of Roddy. Method steps are given in column 8 and any not mentioned there are at least implied by the teaching of the use in well pipe cementing. The fluid could be used in fracturing, before it sets up at least.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any

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invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. **Note however, that this reference is also available under 102(a).**

16. Claims 33-35, 37-39, 43-44, 47-48, 52-56, 58, 68-73, 75-77, 81-82, 85-86, 90-94 and 96 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over disclosures in WO 98/54108. See below for information on 35 USC 103(a) rejections. The WO references teaches cement based materials.

An admixture is disclosed that may include zeolite, SNF (sulphonated naphthalene formaldehyde) which has water content associated with it, clay and hydroxyethyl cellulose, among other components (see pages 3-5). The admixture may be added to oil-well cement (a viscosifier of sorts) (see page 7, line 30); use/steps in well completion is thus implied (or at the very least obvious to one of ordinary skill in the art from this teaching). The cement would of course be useful in well treatments of various types.

The dispersant species elected is actually called out as "sodium naphthalene sulfonate **condensed with** formaldehyde". The WO reference teaches a sulphonated naphthalene formaldehyde, but does not mention sodium specifically. Of course, **the condensate** as called out is a type of SNF, and taking sodium as necessarily relevant when talking about the product itself (which is the species of interest) in water is debatable. Even if the WO reference

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does not anticipate the rejected claims that recite this dispersant (claims 58 and 96) because of this issue concerning sodium, it renders them obvious. A sodium salt would at least be obvious to one of ordinary skill in the art for this sulfonate.

17. Claims 33-35, 37-39, 58, 68-73, 75-77 and 96 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over disclosures by Reddy et al. in US Patent 6,209,646. Reddy teaches well treatment fluids.

Reddy discloses additives for well treating fluids including cement slurries and others for stimulation, completion and drilling (see column 2, lines 60-67). Zeolites may be employed as well as cement slurry dispersants like naphthalene sulfonate formaldehyde condensates (see column 3, lines 30-40 and column 4, lines 33-37). The steps in the method claims rejected are at least implied from the uses taught by Reddy for the fluids disclosed.

The dispersant species elected is actually called out as "sodium naphthalene sulfonate condensed with formaldehyde". Reddy teaches a naphthalene sulphonate formaldehyde condensate, but does not mention sodium specifically. Of course, the condensate as called out is a type of SNF, and taking sodium as necessarily relevant when talking about the product itself (which is the species of interest) in a carrier is debatable. Even if Reddy does not anticipate the rejected claims that recite this dispersant (claims 58 and 96) because of this issue concerning sodium, it renders them obvious. A sodium salt would at least be obvious to one of ordinary skill in the art for this sulfonate.

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18. Claims 33-35, 37-40, 43-44 and 50-51 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over disclosures by Ku in US Patent Application Publication 2002/0117090. Ku teaches various concretes.

Ku teaches concretes containing cement (a viscosifier of sorts), water, Y-Zeolite (a faujasite), SNF and sand (a type of weighting agent) (see paragraphs 25 and 37-39). The compositions of Ku could be used in well treatment, especially in completion.

The dispersant species elected is actually called out as "sodium naphthalene sulfonate condensed with formaldehyde". Ku teaches a sulphonated naphthalene formaldehyde, but does not mention sodium specifically. Of course, the condensate as called out is a type of SNF, and taking sodium as necessarily relevant when talking about the product itself (which is the species of interest) in water is debatable. Even if Ku does not anticipate the rejected claims that recite this dispersant (claims 58 and 96) because of this issue concerning sodium, it renders them obvious. A sodium salt would at least be obvious to one of ordinary skill in the art for this sulfonate.

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

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be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

20. Claims 33, 38, 52, 56-57, 68, 75-76, 89-90, 94-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller et al. in US Patent 4,888,120. Mueller has been discussed in detail above.

Mueller discloses all of the limitations of the rejected claims in context, except for (perhaps) the exact ranges of claims 56-57 (polymer), 89 (viscosifier) and 94-95 (polymer). One of ordinary skill in the art would have made compositions in the ranges of these rejected claims in the course of routine optimization of viscosity in the compositions of Mueller, thus rendering them obvious.

21. Claims 33, 38, 58-60, 68, 76 and 96-98 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reddy et al. in US Patent 6,209,646. Reddy has been discussed in detail above.

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Reddy discloses all of the limitations of the rejected claims in context, except for (perhaps) the exact ranges of claims 59-60 (dispersant) and 97-98 (dispersant). One of ordinary skill in the art would have made compositions in the ranges of these rejected claims in the course of routine optimization of dispersion of components in the compositions of Reddy, thus rendering them obvious.

22. Claims 33, 38, 65-68, 76 and 103-105 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terry et al. in US Patent 5,711,383. Terry has been discussed in detail above.

Terry discloses all of the limitations of the rejected claims in context, except for (perhaps) the exact ranges of claims 66-67 (weighting material) and 104-105 (weighting material). One of ordinary skill in the art would have made compositions in the ranges of these rejected claims in the course of routine optimization of the density of the compositions of Terry, thus rendering them obvious.

23. Claims 33, 38, 61, 63-64, 68, 76, 99 and 101-102 are rejected under 35 U.S.C. 103(a) as being obvious over Roddy in US Patent 6,457,524. Roddy has been discussed in detail above.

Roddy discloses all of the limitations of the rejected claims in context, except for (perhaps) the exact ranges of claims 63-64 (surfactant) and 101-102 (surfactant). One of ordinary skill in the art would have made compositions in the ranges of these of these rejected claims in the course of routine optimization of

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distribution of components in the compositions of Roddy, thus rendering them obvious.

The applied reference may have a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome (at least in part) by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2). **Note however that the reference is also available under 102(a).**

24. Claims 33, 39-40, 68 and 77-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross et al. in US Patent 2,094,316. Cross has been discussed in detail above.

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The species election by Applicant for zeolite was to clinoptilolite (see above); there has been no rejection so far as to claims 77-78 using a teaching of clinoptilolite. However, this species in the context of claims 77-78 is obvious as follows.

As seen above, Cross teaches all of the limitations of the rejected claims, but does not specifically teach clinoptilolite; it does teach that a variety of zeolites may be used and natrolite is specifically mentioned. As Applicant has admitted on page 3 of the specification, natrolite and clinoptilolite are both zeolites and of the same general formula (the same as in claims 39 and 77), and more specifically, they are both hydrated sodium aluminum silicates. Cross makes a point of the importance of Na/Ca-Mg base exchange in its teachings which of course would apply to clinoptilolite as it does to natrolite; the rejected claims are comprising, thus allowing the possibility of any exchange fluids needed being present.

It would have been obvious to one of ordinary skill in the art to use known base exchange zeolites such as clinoptilolite in the fluids of Cross given the teaching that base exchange zeolites are useful therein (see column 3, lines 26-28).

Double Patenting

25. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re*

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Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

26. Claims 33-34, 39, 68-69, 71 and 77 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,889,767. Although the conflicting claims are not identical, they are not patentably distinct from each other. Claim 7 of the patent discloses a composition having a zeolite in a carrier used in well completion – this meets the limitations of the rejected claims, so of course renders them obvious to one of ordinary skill in the art.

27. Claims 33-34, 38-40, 68-69, 71, 76-78 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 39-40, 58 and 65 of copending Application No. 10/315,415. Although the conflicting claims are not identical (the scope of use is different as the 10/315,415 claims are narrower as they relate only to cementing/completion), they are not patentably distinct from each other. The cited claims of 10/315,415 disclose a composition having a zeolite in a carrier

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used in cementing a well (completion) (and claim 65 of 10/315,415 discloses use of a dispersant) which meets the limitations of the rejected claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

28. Claims 33-35, 38-40, 44, 68-70, 76-78 and 82 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 10-11 and 23 of copending Application No. 10/727,370. Although the conflicting claims are not identical (the scope of use is different as the 10/727,370 claims are narrower as they relate to drilling), they are not patentably distinct from each other. The cited claims of 10/727,370 disclose a drilling composition having a zeolite in a carrier fluid and comprising the same components as the rejected claims, thus which meeting the limitations of the rejected claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

29. Claims 33-35, 39-40, 44, 68-71, 77-78 and 82 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 13-14, 16, 19, 30-31, 33 and 36-37 of copending Application No. 10/738,199. Although the conflicting claims are not identical (the scope of use is different as the 10/738,199 claims are narrower as they relate to drilling), they are not patentably distinct from each other. The

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cited claims of 10/738,199 disclose a drilling composition having a zeolite in a carrier fluid and comprising the same components as the rejected claims, thus which meeting the limitations of the rejected claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

30. Claims 33-35, 37, 38-40, 52-54, 65, 68-71, 75-78, 90-92 and 103 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 7-8, 11, 20, 22, 33-35, 39-40, 43, 52 and 54 of copending Application No. 10/795,158. Although the conflicting claims are not identical (the scope of use is different as the 10/795,158 claims are narrower as they relate to drilling), they are not patentably distinct from each other. The cited claims of 10/795,158 disclose a drilling composition having a zeolite in a carrier fluid and comprising the same components as the rejected claims, thus which meeting the limitations of the rejected claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

31. Claims 33-34, 39-40, 44, 52-54, 68-69, 71, 77-78, 82, and 90-92 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 14, 18, 50-52 and 65 of copending Application No.10/816,034. Although the conflicting claims are not

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identical (the scope of use is different as the 10/816,034 claims are narrower as they relate to cementing/completion), they are not patentably distinct from each other. The cited claims of 10/816,034 disclose a cementing composition having a zeolite in a carrier fluid and comprising the same components as the rejected claims, thus which meeting the limitations of the rejected claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

32. Claims 33-35, 39-40, 44, 68-71, 77-78 and 82 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 14, 20-21, 23, 26 and 33-35 of copending Application No.10/822,459. Although the conflicting claims are not identical (the scope of use is different as the 10/822,459 claims are narrower as they relate to drilling), they are not patentably distinct from each other. The cited claims of 10/822,459 disclose a drilling composition having a zeolite in a carrier fluid and comprising the same components as the rejected claims, thus which meeting the limitations of the rejected claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

33. Claims 33-34, 39-40, 44, 68-69, 77-78 and 82 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 10-11, 13, 34, 37-38, 55, 59 and

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62-63 of copending Application No.10/901,507. Although the conflicting claims are not identical (the scope of use is different as the 10/901,507 claims are narrower as they relate to cementing), they are not patentably distinct from each other. The cited claims of 10/901,507 disclose a cementing composition having a zeolite in a carrier fluid and comprising the same components as the rejected claims, thus which meeting the limitations of the rejected claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

34. Claims 33-34, 39-40, 68-69 and 77-78 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 11-12, 23, 33-34, 47, 55-56, 65, 73-74 and 98 of copending Application No.10/939,902. Although the conflicting claims are not identical (the scope of use is different as the 10/939,902 claims are narrower as they relate to cementing), they are not patentably distinct from each other. The cited claims of 10/939,902 disclose a cementing composition having a zeolite in a carrier fluid and comprising the same components as the rejected claims, thus which meeting the limitations of the rejected claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

35. Claims 33-34, 39-40, 44, 68-69, 77-78 and 82 are provisionally rejected under the judicially created doctrine of obviousness-type double

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patenting as being unpatentable over claims 1, 11, 12, 19 and 20 of copending Application No.10/954,116. Although the conflicting claims are not identical (the scope of use is different as the 10/954,116 claims are narrower as they relate to cementing), they are not patentably distinct from each other. The cited claims of 10/954,116 disclose a cementing composition having a zeolite in a carrier fluid and comprising the same components as the rejected claims, thus which meeting the limitations of the rejected claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

36. Claims 33-34 and 44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over an obvious combination of claims 4 and 16 of copending Application No.11/001,442. Although the conflicting claims are not identical (the scope of use is different as the 11/001,442 claims are narrower as they relate to cementing), they are not patentably distinct from each other. The cited claims of 11/001,442 disclose a cementing composition having a zeolite in a carrier fluid and comprising the same components as the rejected claims, thus which meeting the limitations of the rejected claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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37. Claims 33-34, 39-40 and 44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 15-16, 21, 26, 29 and 31-33 of copending Application No.11/126,626. Although the conflicting claims are not identical (the scope of use is different as the 11/126,626 claims are narrower as they relate to cementing), they are not patentably distinct from each other. The cited claims of 11/126,626 disclose a cementing composition having a zeolite in a carrier fluid and comprising the same components as the rejected claims, thus which meeting the limitations of the rejected claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

38. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. These references disclose compositions and/or methods at least similar to those of the present invention: US Patents 2,727,001; 3,047,493; 4,468,334; 4,548,734; 4,552,591; 4,650,593; 5,807,810; 6,722,434 and 6,767,868; as well as US Patent Application Publications 2003/0153466; 2004/0262000; and 2004/0262001; and Japanese JP7003254A.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to C. R. Richard whose telephone number is


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571-272-8502. The Examiner can normally be reached on M-Th, 8am-6pm and alternate Fridays 8am-5pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PHILIP TUCKER
PRIMARY EXAMINER
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